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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,446	01/07/2005	Kouichiro Shiraishi	330-285	7518

23117 7590 02/28/2006

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EXAMINER

SPEER, TIMOTHY M

ART UNIT PAPER NUMBER

1775

DATE MAILED: 02/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/510,446	SHIRAISHI ET AL.	
	Examiner	Art Unit	
	Timothy M. Speer	1775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Office Action

1. The response to the Office Action dated 06/02/2005 is acknowledged. Rejections made in the Office Action but not repeated herein have been withdrawn in view of applicant's response.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 4-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Kishimoto (USPN 6,399,527).

Kishimoto teaches substrates for information recording media, wherein the glass consists essentially the metal oxides recited in instant claim 1 (see examples 1-5 and 7-13). The media may comprise, for instance, the glass substrate and a recording layers formed thereon.

Regarding the recitation in instant claim 1 that the glass contains more than 55 mol% silica, example 11 in Kishimoto discloses 54.8 mol% silica, which, to two significant digits, represents 55 mol% silica. The language more than 55% as employed in the present claims includes very small amounts greater than 55 mol%, such as 55.0000001 mol%, which, to two significant digits, is the same as that disclosed in Kishimoto. Accordingly, it is the Examiner's position that the present claims are not patentably distinct from Kishimoto. Since the compositions of Kishimoto are the same as those presently claimed, it is the Examiner's positions that the compositions of

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Kishimoto will inherently exhibit the presently claimed surface roughness and other physical characteristics.

Although the compositions of Kishimoto appear to include additional components than recited in the present claims, it is the Examiner's position that the present claim language does not exclude such additional components. The transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristics" of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976). For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." See, e.g., *PPG*, 156 F.3d at 1355, 48 USPQ2d at 1355. If an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. *In re De Lajarte*, 337 F.2d 870, 143 USPQ 256 (CCPA 1964). In the present case, applicant has failed to demonstrate that additional components present in the glasses of Kishimoto would affect the basic and novel characteristics of the claimed invention. Accordingly, absent such a showing, it is the Examiner's position that the present claims are anticipated by Kishimoto.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 and 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koyama (USPN 6,306,786).

Koyama discloses glass compositions for recording media that overlap the presently claimed ranges (see Koyama at col. 2, ll. 29-39 & 48-55, for instance). A prima facie case of obviousness arises when the ranges of a claimed composition overlap the ranges disclosed in the prior art. See *In re Peterson*, 315 F.3d 1325, 1329 (Fed. Cir. 2003). Therefore, since the compositions of Koyama overlap the presently claimed compositions, it is the Examiner's position that the present claims are prima facie obvious thereover, absent a showing of unexpected results. Regarding the presently recited physical characteristics of surface roughness and Young's modulus, it is not inventive to discover properties inherent in a composition suggested by the prior art. Therefore, these limitations are not considered to distinguish over Koyama.

Response to Arguments

6. Applicant's arguments filed 11/29/05 have been fully considered but they are not persuasive. Applicant argues that Kishimoto fails to teach the presently claimed silica content. As noted above with respect to Kishimoto, it is the Examiner's that the present claim language fails to distinguish patentably over Kishimoto. That argument is incorporated herein. With respect to Koyman, applicant again urges that the applied prior art fails to teach the presently claimed silica content. As noted above, Koyama discloses compositions which overlap the

presently claimed ranges and, accordingly, render the present claims prima facie obvious thereover.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy M. Speer whose telephone number is 571-272-8385. The examiner can normally be reached on M-Th, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah D. Jones can be reached on 571-272-1535. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Timothy M. Speer



JENNIFER MCNEIL
PATENT EXAMINER
2/21/06